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09/349,708	07/08/1999	CHARLES WILLIAM BERTHOUD	BERTHOUD-16-	7016

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EXAMINER

BUI, BING Q

ART UNIT	PAPER NUMBER
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2642

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/349,708

Applicant(s)

Berthoud et al

Examiner

Bing Bui

Art Unit

2642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jul 12, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

Art Unit: 2642

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. Claim 29 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 29, line 5, the phrase "said call related information" is indefinite and lacks antecedent basis.

### ***Claim Rejections - 35 USC § 102***

2. Claims 1-5, 8-15, 17, 19-29, 32-36, 38-42 and 44 are rejected under 35 U.S.C. 102(e) as being anticipated by Smock et al (US Pat No. 6,377,668).

**Regarding claim 1**, with respect to Figure 1, Smock et al teach the invention as claimed, a system for notifying a called-but-busy party 16 of an incoming telephone call attempt over a telephone line while the called-but-busy party 16 is accessing the Internet over the same telephone line 50, comprising:

Internet communication module (Fig 1, element 68 and col 3, ln 8-34); and

a message formatter (Fig 1, element 64 and col 3, ln 66-col 4, ln 4);

wherein said Internet communication module is adapted to cause said message formatter to send a personalized notification message (e.g. announcing the name and

Art Unit: 2642

telephone number of the caller) to said called-but-busy party upon request from a caller (remote telephone user) (Abstract; Fig 1; col 3, ln 66-col 4, ln 4 and col 5, ln 18-22).

**Regarding claim 2**, with respect to Figure 1, Smock et al teach the invention as claimed, an apparatus for notifying a called-but-busy party of an incoming telephone call attempt over a telephone line while the called-but busy party is accessing the Internet over the same telephone line according to claim 1 (Fig 1 and Abstract); Smock et al do not explicitly teach ,the remote telephone user is a central office; however, as it can be seen by an ordinary skill in the art, an incoming call transparently comes from a different or the same central office with the called-but-busy party via phone line 10 (Fig 1 and col 3, ln 8-45).

**Regarding claim 3**, with respect to Figure 1, Smock et al teach the invention as claimed, the apparatus for notifying a called-but-busy party of an incoming telephone call attempt over a telephone line 50 while the called-but busy party is accessing the Internet over the same telephone line 50 according to claim 1, wherein said remote telephone user is a party trying to establish a telephone call with said called-but-busy party (Abstract; Fig 1 and col 2, ln 28-40).

**Regarding claim 4**, with respect to Figure 1, Smock et al teach the invention as claimed, the apparatus for notifying a called-but-busy party of an incoming telephone call attempt over a telephone line while the called-but busy party is accessing the Internet over the same telephone line according to claim 1, further comprising:

Art Unit: 2642

a call related information receiver 32 (Abstract; Fig 1; col 3, ln 39-45 and col 3, ln 66-col 4, ln 4);

wherein call related information regarding a calling party is included with said notification message (Abstract; Fig 1; col 3, ln 39-45 and col 3, ln 66-col 4, ln 4).

**Regarding claim 5**, with respect to Figure 1, Smock et al teach the invention as claimed, the apparatus for notifying a called-but-busy party of an incoming telephone call attempt over a telephone line while the called-but busy party is accessing the Internet over the same telephone line according to claim 1, wherein said call related information receiver is a Caller ID receiver (Abstract; Fig 1; col 3, ln 39-45 and col 3, ln 66-col 4, ln 4).

**Regarding claim 8**, with respect to Figure 1, Smock et al teach the invention as claimed, the apparatus for notifying a called-but-busy party of an incoming telephone call attempt over a telephone line while the called-but busy party is accessing the Internet over the same telephone line according to claim 1, further comprising said notification message includes an audibly playable data file (Abstract; Fig 1; col 3, ln 66-col 4, ln 4 and col 5, ln 18-22).

**Regarding claim 9**, with respect to Figure 1, Smock et al teach the invention as claimed, the apparatus for notifying a called-but-busy party of an incoming telephone call attempt over a telephone line while the called-but busy party is accessing the Internet over the same telephone line according to claim 1, wherein said audibly

Art Unit: 2642

playable data file automatically plays when received on a computer terminal of said called-but-busy party (Abstract; Fig 1; col 3, ln 66-col 4, ln 4 and col 5, ln 18-22).

**Regarding claim 10**, with respect to Figure 1, Smock et al teach the invention as claimed, apparatus for notifying a called-but-busy party of an incoming telephone call attempt over a telephone line while the called-but busy party is accessing the Internet over the same telephone line according to claim 1, further comprising: a data signal detector adapted to detect likely Internet usage of said called-but-busy party (Abstract; Fig 1; col 3, ln 66-col 4, ln 4 and col 5, ln 18-22).

**Regarding claim 11**, with respect to Figure 1, Smock et al teach the invention as claimed, the apparatus for notifying a called-but-busy party of an incoming telephone call attempt over a telephone line while the called-but busy party is accessing the Internet over the same telephone line according to claim 10, wherein said notification message includes information regarding likely Internet usage of said called-but-busy party (Abstract; Fig 1; col 3, ln 66-col 4, ln 4 and col 5, ln 18-22).

**As to claims 12 and 33**, they are rejected for the same reasons set forth to rejecting claim 1 above, since claims 12 and 33 are merely a method of operation for the system defined in the system claim 1.

**Regarding claim 13**, with respect to Figure 1, Smock et al teach the invention as claimed, the method for notifying a n Internet user of a telephone line that a calling party is attempting to connect with said Internet user according to claim 12, further

Art Unit: 2642

comprising receiving a notification request from said calling party (Abstract; Fig 1; col 3, In 66-col 4, In 4 and col 5, In 18-22).

**Regarding claim 14**, with respect to Figure 1, Smock et al teach the invention as claimed, the method for notifying a n Internet user of a telephone line that a calling party is attempting to connect with said Internet user according to claim 12, further comprising receiving a notification request from a central office (Abstract; Fig 1; col 3, In 66-col 4, In 4 and col 5, In 18-22).

**Regarding claim 15**, with respect to Figure 1, Smock et al teach the invention as claimed, the method for notifying a n Internet user of a telephone line that a calling party is attempting to connect with said Internet user according to claim 12, further comprising determining at a central office a likelihood that said Internet user is connected with said Internet (Abstract; Fig 1; col 3, In 66-col 4, In 4 and col 5, In 18-22).

**Regarding claim 17**, with respect to Figure 1, Smock et al teach the invention as claimed, the method for notifying a n Internet user of a telephone line that a calling party is attempting to connect with said Internet user according to claim 12, wherein said notification is an audibly playable message (Abstract; Fig 1; col 3, In 66-col 4, In 4 and col 5, In 18-22).

**As to claims 19-22** , they are rejected for the same reasons set forth to rejecting claims 12-15, respectively.

Art Unit: 2642

**As to claims 23-24**, they are rejected for the same reasons set forth to rejecting claims 7-8, respectively.

**As to claims 25-26 and 39**, they are rejected for the same reasons set forth to rejecting claim 1.

**As to claims 27-29 and 32**, they are rejected for the same reasons set forth to rejecting claims 3-5 and 8, respectively.

**As to claims 34-36**, they are rejected for the same reasons set forth to rejecting claims 13-15 above, since claims 34-36 are merely a method of operation for the system defined in the system claims 13-15, respectively.

**As to claim 38**, it is rejected for the same reasons set forth to rejecting claim 8.

**As to claims 40-42 and 44**, they are rejected for the same reasons set forth to rejecting claims 13-15 and 8 above, since claims 40-42 and 44 are merely a system for operation the method defined in the method claims 13-15 and 8, respectively.

3. Claim 18 is rejected under 35 U.S.C. 102(e) as being anticipated by Norris et al (US Pat No. 5,805,587) , of record.

**Regarding claim 18**, with respect to Figure 1, Norris et al teach the invention as claimed, a method for notifying a n Internet user of a telephone line that a calling party is attempting to connect with said Internet user, comprising:



Art Unit: 2642

determining at a central office a likelihood that said Internet 10 user is connected with said Internet (Fig 1 and col 5, ln 48-col 6, ln 15); and

notifying a n attempted calling party to said Internet user of said likelihood from said central office (Fig 1 and col 5, ln 48-col 6, ln 15).

giving said calling party an opportunity to leave a message to the internet user in a voice mail (e.g. personal message sent to the internet user by the calling party) (Fig 6 and col 8, ln 20-49).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner

Art Unit: 2642

to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 6-7, 16, 30-31, 37 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smock et al (US Pat No. 6,377,668) in view of Foladare et al (US Pat No. 5,982,774), of record.

**Regarding claims 6-7, 16, 30-31, 37 and 43**, Smock et al teach the invention substantially as claimed, with the exception of providing notification message is a textual message such as e-mail message. However, Foladare et al teach the notification message sent to an internet user and displayed on internet user's computer terminal in form of page (col 3, ln 13-35). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify a method and system for notifying an on-going internet user an incoming call in form of page as taught by Foladare et al into communication system of Smock et al to provide the called party a flexible way in recognizing the content of the notification.

### ***Response to Arguments***

6. Applicant's arguments with respect to claims 1-17 and 19-25 have been considered but are moot in view of the new ground(s) of rejection.

Art Unit: 2642

2. Applicant's arguments with respect to claim 18 have been fully considered but they are not persuasive.

Examiner agrees with the Applicant that Norris fails to send a notification to an on-going internet user in form of personalized message upon receiving a call from a caller. However, as to claim 18, when caller is given an opportunity to leave a message to the internet user in a voice mail as taught by Norris (Fig 6 and col 8, ln 20-49), such message is considered as personal message. Therefore, the rejection of claim 18 is maintained with Norris.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Gurbani et al (US Pat no. 6,282,275) disclose the caller identification log with internet access.

Borland (US Pat No. 6,122,347) discloses a system and method for self-announcing a caller of an incoming call.

Luneau (US Pat No. 6,038,443) discloses a calling party announcement apparatus.

Birckbichler (US Pat No. 5,796,806) provides an audible identification from a caller.


Art Unit: 2642

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bing Bui whose telephone number is (703) 308-5858. The examiner can normally be reached on Monday through Thursday from 7:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on (703) 305-4731. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314 and for formal communications intended for entry (please label the response "EXPEDITED PROCEDURE") or for informal or draft communications not intended for entry (please label the response "PROPOSED" or "DRAFT").

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

BING BUI  
Jul 28, 2002



AHMAD MATAR  
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